



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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THE MENTHOLATUM COMPANY,

Opposer,

v.

THEROX, INC.,

Applicant.

78116476
Opposition No.: 91/160,810

REPLY BRIEF OF OPPOSER



04-09-2007

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BRIEF OF OPPOSER

I. STATEMENT OF THE CASE

Opposer, The Mentholatum Company (hereinafter "Mentholatum" or "Opposer") through a predecessor in interest, filed a Notice of Opposition against the mark OXIUM which is the subject of U.S. Trademark Application Serial No. 78/116,976 for goods identified as "oxygenated skin care preparations, namely, creams, masks, gels and lotions for the face, hands, feet and body, not including acne preparations".

Applicant, TherOx, Inc., filed the OXIUM application on March 22, 2002 based on its bona fide intent to use the mark in commerce.

As grounds for the Opposition, Opposer asserts prior use and registration of various marks which comprise or include the term OXY, either by itself or with other wording, for goods described as acne medication, skin care preparations, skin wash and skin cleansers, such that the use by Applicant of its OXIUM mark for the goods described in Applicant's application would

be likely to result in confusion, mistake or deception for purposes of Section 2(d) of the Trademark Act.

Applicant, in its Answer to the Notice of Opposition, denied the allegations therein.

Thereafter, each party, as more fully discussed below took testimony and offered other evidence in support of their positions in the Opposition.

II. THE RECORD BEFORE THE BOARD

The evidentiary record before the Board in this case consists of the pleadings, the file history for the OXIUM application, and the following testimony and evidence submitted by the parties.

Opposer's Testimony and Evidence

1. Pursuant to Trademark Rule 2.122(d), Opposer's Notice of Reliance on nine (9) registrations, together with certified status and title copies of the registrations.
2. Pursuant to Trademark Rule 2.122(e), a Notice of Reliance on twenty-seven (27) registrations held by third parties.
3. Opposer's testimony deposition of James C. Brown, taken on October 11, 2006, including exhibits and portions of the Brown deposition designated as "Confidential" pursuant to a stipulated protective order entered by the parties.
4. Opposer's testimony deposition of Todd S. Cantrell, taken on October 19, 2006, including exhibits and portions of the Cantrell deposition designated as "Confidential" pursuant to a stipulated protective order entered by the parties.
5. Pursuant to Trademark Rule 2.122(e), a Notice of Reliance on six (6) registrations held by third parties.

Applicant's Testimony and Evidence

1. Applicant's testimony deposition of Jeffrey Creech, taken on December 19, 2006 with exhibits.

A. Opposer's Testimony and Evidence

1. Opposer's Notice of Reliance On Its Trademark Registrations

As stated, Opposer submitted and relied on certified status and title copies of nine of its registrations. These registrations are:

<i>Mark</i>	<i>Registration No.</i>	<i>Issue Date</i>	<i>Goods</i>
OXY	1,869,207	12/27/94	Acne medication
OXY (Stylized)	1,873,555	01/17/95	Acne medication
OXY 10	1,141,969	12/02/80	Medication for treatment of Acne
THINK OXY, THINK OXYGEN	2,582,225	06/18/02	Acne Medication
OXY & Design	2,919,984	01/18/05	Topical acne medication, medicated face wash and medicated skin wipes
OXY Design	2,874,733	08/17/04	Topical acne medication, medicated face wash and medicated skin wipes
OXY (stylized)	2,919,983	01/18/05	Topical acne medication, medicated face wash and medicated skin wipes
OXY BALANCE ON-THE-GO	2,480,829	08/21/01	Acne medication
THE OXYGENATOR	2,685,219	02/11/03	Video game software which is downloadable from a global computer network for the specific purpose of promotion of applicant's skincare products

Opposer's registrations establish Opposer's priority in and to its various OXY marks and show that Opposer has adopted OXY as a mark, both alone and in combination with other wording, for acne medication, skin care preparations, skin wash and skin cleansers.

2. Opposer's Notice of Reliance on Third Party Registrations

Opposer submitted two notices of reliance on third party registrations: the first of these was submitted during Opposer's testimony period and the second during Opposer's rebuttal period.

As stated in both of these Notices, Opposer submitted these registrations to show that third parties have commonly adopted and registered the same marks both for cosmetic goods in International Class 3 and for acne preparations in International Class 5.¹

3. Opposer's Brown Deposition

Opposer took the testimony of James C. Brown on October 11, 2006. Mr. Brown was employed by SmithKline Beecham Corporation (hereinafter "SmithKline"), Opposer's predecessor in interest, as the brand manager for the OXY brand before The Mentholatum Company acquired the OXY marks and brand (Brown Dep., p. 11, lns. 5-10).² As brand manager, Mr. Brown was charged with communicating the OXY brand to the customer (Brown Dep., p. 11, lns. 11-20). While brand manager, Mr. Brown became familiar with historical

¹ The registrations accompanying the Notice of Reliance submitted during Opposer's rebuttal period were for marks that Applicant considered competitive to Applicant's OXIUM mark and products (Creech Dep., p. 16, lns. 10-25; p. 17, ln. 1, Ex. 2).

² Given that Opposer's predecessor in interest, SmithKline, filed this opposition and remained the named Opposer for some time, Mr. Brown's role as prior brand manager established priority, use and fame of the OXY marks.

documents relevant to the marketing, promotion and sale of products under the OXY marks (Brown Dep., p. 12, lns. 10-25; p. 13, lns. 1-10).

The Brown deposition shows that the OXY mark was first used in the early 1970's in connection with acne preparations (Brown Dep., p. 13, lns. 18-21, Exs. 4 and 5). The OXY mark has been used continuously since that time (Brown Dep., p. 13, lns. 11-17).

SmithKline offered a number of products under the OXY mark including daily cleansing pads, a wash and treatment cream (Brown Dep., p. 14, lns. 19-25; p. 15, lns. 1-11, Ex. 2). All of the products were used for the treatment of acne. (Brown Dep., p. 15, lns. 12-15). The OXY products sold in the \$3 to \$6 range and were offered in a wide variety of stores, such as Wal-Mart, K-Mart, Target, CVS, Rite Aid, Walgreens, Kroger and Safeway (Brown Dep., p. 18, lns. 22-25; p. 19, lns. 1-11; p. 48, lns. 2-8, Ex. 6).

OXY branded products are purchased by a wide range of consumers from young teens to adults (Brown Dep., p. 20, lns. 9-24).

At the time Mentholatum acquired the OXY brand and line of products, the OXY brand comprised about ten (10) percent or slightly more of the acne care market (Brown Dep., p. 48, lns. 24-25; p. 49, lns. 1-3).

Advertising and promotion for the OXY brand has included a variety of media over the last thirty years. The products have been advertised on television since at least 1975 (Brown Dep., Exs. 4 and 5). There was significant promotion of the OXY brand on the Internet at the *oxyoxygen.com* website (Brown Dep., p. 23, lns. 21-25; p. 24, lns. 1-2). Advertisements ran in national print publications such as Teen People and Sports Illustrated for Teens (Brown Dep.,

p. 23, lns. 14-18). Other promotional efforts included free-standing inserts (FSIs) in newspapers and in-store shelf displays (Brown Dep., p. 24, lns. 5-16; p. 27, lns. 24-25; p. 26, lns. 1-25; p. 27, lns. 1-10, Exs. 6 and 7). There have also been radio advertisements (Brown Dep., -confidential portion- p. 15, lns. 5-7). Other forms of promotion included sending consumer press kits to writers of national publications and endorsements or co-promotions with well-known musical groups (Brown Dep., p. 44, lns. 20-25; p. 45, lns. 1-13 -confidential portion- p. 15, lns. 11-17, Ex. 11).

The Brown testimony also evidences that Opposer, through its predecessor in interest, developed special promotions for the OXY brand. In 2004, there was an Internet contest to develop a new character for the OXY brand (Brown Dep., p. 31, lns. 12-21). The promotion was designed to have teenagers visit the Oxy website and enter a contest whereby they submitted new characters for the OXY brand marketing campaign (Brown Dep., p. 31, lns. 12-21, Ex. 7). The promotion ran on the Oxy website, in movie theaters, in FSIs and through in-store promotions (Brown Dep., p. 29, lns. 11-25; pp. 30-38; p. 39, lns. 1-6). Teenagers were also encouraged to use instant messaging to share information about the OXY brand and the contest (Brown Dep., p. 29, lns. 11-25; p. 30, lns. 1-16, Ex. 7). Over 840 million people saw the instant messaging imagery (Brown Dep., p. 33, lns. 5-10, Ex. 7).

A second advertising campaign launched in 2004 under the title Oxy 2004 Back to School Oxy Tunes (Brown Dep., p. 39, lns. 7-13, Ex. 8). The OXY Tunes promotion offered OXY consumers the chance to win tickets to a music video award show and other prizes (Brown Dep., p. 40, lns. 8-13; p. 41, lns. 23-25; p. 42, ln. 1). Opposer promoted the program through FSIs, shelf talkers, in-store displays and on the Internet (Brown Dep., p. 39, lns. 10-25, p. 40, lns. 1-4, Ex. 8).

In 2004, Opposer's predecessor in interest also offered an Oxy loyalty program (Brown Dep., p. 42, lns. 24-25; p. 43, lns. 1-3, Ex. 9). The loyalty program encouraged purchasers to buy OXY products (Brown Dep., p. 43, lns. 4-8). Items available through the program included downloads of music, opportunities for tickets, and other items (Brown Dep., p. 43, lns. 16-23, Ex. 9).

The Brown testimony illustrates the continuous use of the OXY mark on acne products for thirty years. It further shows consumer recognition of the OXY brand. This recognition is a

result of Opposer's long use of, extensive advertising and promotion of, and broad retail outlet placement of the OXY products.

4. Opposer's Cantrell Deposition

On October 19, 2006, Opposer took the testimony deposition of Todd S. Cantrell. Mr. Cantrell is the current brand manager for the OXY brand and is employed by Opposer (Cantrell Dep., p. 8, lns. 17-18; p. 11, lns. 15-18).

In his role as brand manager, Mr. Cantrell is responsible for managing the brand which includes product development, advertising and promotion, sales and manufacturing (Cantrell Dep., p. 11, lns. 21-23; p. 12, lns. 1-5). He has held that position since June 2005 (Cantrell Dep., p. 11, lns. 15-20). As brand manager, Mr. Cantrell reviewed historical documents for the OXY brand including sales and marketing materials (Cantrell Dep., p. 12, lns. 19-23; p. 13, lns. 1-20).

Today, OXY products are found in all fifty states and throughout the world - in South America, Asia, Africa and Europe (Cantrell Dep., p. 13, lns. 21-23; p. 14, lns. 1-3). Cleansing pads, facial washes, spot treatments and facial scrubs are currently offered under the OXY mark (Cantrell Dep., p. 14, lns. 4-8, Ex. 2). Since Opposer acquired the OXY mark and product line, it has added products to the OXY line (Cantrell Dep., p. 16, lns. 11-20). These additions include a new scrub, pad and facial wash (Cantrell Dep., p. 16, lns. 18-20). Opposer's OXY products are sold virtually everywhere: mass drug stores and grocery stores including Wal-Mart, Target, CVS, Rite Aid, Eckerd, Brooks and Longs (Cantrell Dep., p. 17, lns. 18-22). The retail price for OXY products ranges from just under \$5 to almost \$7 (Cantrell Dep., p. 18, lns. 12-16).

After Opposer acquired the OXY brand, it adopted a new color scheme and in some cases new packaging for the OXY products (Cantrell Dep., p. 17, lns. 2-17, Ex. 2). The new

packaging and introduction of the Chill Factor product increased sales of the OXY product in at least one store, Wal-Mart (Cantrell Dep., p. 20, lns. 4-23; p. 21, lns. 1-9, Ex. 3).

To promote the OXY product, Opposer has placed print and television advertisements, has placed free standing inset coupons, and has participated in the Dew Action Tour (Cantrell Dep., p. 23, lns. 22-23; p. 24, lns. 1-5). Print advertisements have appeared in Sports Illustrated For Kids, MAD Magazine, Transworld, DC Comics, and Future Skateboarding (Cantrell Dep., Ex. 4). OXY television sports have been seen on NBC, the USA Network, MTV and Comedy Central (Cantrell Dep., Ex. 4).

One of Opposer's biggest promotions is the Dew Action Sports Tour - an extreme sports competition (Cantrell Dep., p. 24, lns. 6-11). The Tour is a partnership between Live Nation (formerly Clear Channel and one of the largest outdoor entertainment companies in the United States) and NBC (Cantrell Dep., p. 24, lns. 8-15). Mountain Dew is the title sponsor of the event (Cantrell Dep., p. 24, lns. 8-11).

The Tour begins in June and ends in October (Cantrell Dep., p. 24, lns. 20-23). It is held in five U.S. cities (Cantrell Dep., p. 24, lns. 16-19). Teenage boys are the primary attendees and are often accompanied by their parents (Cantrell Dep., p. 25, lns. 1-4). The events run from Thursday to Sunday and draw crowds of 15,000 to 20,000 (Cantrell Dep., p. 27, ln. 23; p. 28, lns. 1-3).

Opposer is an associate sponsor of the Tour and maintains a large "booth" where attendees can receive samples, play games, and win prizes (Cantrell Dep., p. 25, lns. 5-23; p. 26, lns. 1-23; p. 27, lns. 1-22, Exs. 5 and 6). One of the competitors in the Tour is David Mirra (Cantrell Dep., p. 25, lns. 16-23; p. 26, lns. 1-16; p. 32, lns. 11-23, Ex. 5). Mirra competes in

BMX events and is the most decorated athlete in extreme sports history (Cantrell Dep., p. 32, Ins. 14-21). Opposer is one of Mirra's sponsors (Cantrell Dep., p. 32, Ins. 11-23; p. 33, Ins. 1-13). Mirra's helmet, which he wears at all of his competitions, displays the OXY logo (Cantrell Dep., p. 33, Ins. 5-16, Ex. 2).

Other OXY promotions include product placement on Real World, a show distributed through and aired on MTV (Cantrell Dep., p. 34, Ins. 13-21). Opposer also has in-store promotions (Cantrell Dep., p. 34, Ins. 22-23; p. 35, Ins. 1-23, Ex. 11). At times, Opposer has run contests online (Cantrell Dep., Exs. 2 and 12). Opposer also engages in sampling, most recently with over 600,000 children at sports camps (Cantrell Dep., p. 39, Ins. 15-23; p. 40, Ins. 1-5).

In addition, further evidence of the public recognition of the OXY brand is seen from a survey of pharmacists. OXY is the number one recommended brand of acne product among pharmacists according to the National Pharmacists Association in 2005 (Cantrell Dep., p. 15, Ins. 14-23; p. 16, Ins. 1-4).

The Cantrell Deposition shows that Opposer has actively and continuously promoted, marketed and sold OXY branded products since acquiring the brand. The testimony further shows a high level of public recognition of the OXY mark.

B. Applicant's Testimony

On December 19, 2006, Applicant took the testimony deposition of Jeffrey Creech, program manager of research and regulatory affairs (Creech Dep., p. 7, lns. 7-9).

According to Mr. Creech, Applicant is a registered medical device manager with the FDA (Creech Dep., p. 8, lns. 7-11). In addition, Applicant has developed an oxygenated cream to use for cosmetic purposes (Id.). In 2002, TherOx selected the name OXIUM to identify its oxygenated skin care preparations (Creech Dep., Ex. 2, p. 414). On March 22, 2002, TherOx filed an intent to use trademark application for the mark OXIUM for oxygenated skin care preparations, namely, creams, masks, gels and lotions for the face, hands, feet and body, not including acne preparations.

Although Applicant filed an intent to use application for its OXIUM mark and did not file an amendment to allege use during the prosecution of that application, Applicant indicates that it used the OXIUM mark for an oxygenated cream for a brief period of time in a limited test market (Creech Dep., p. 54, lns. 18-25; p. 55, lns. 1-11). The product is not now available (Creech Dep., p. 55, lns. 4-11). The product offered under Applicant's mark was an oxygenated cream in a pressurized one ounce can (Creech Dep., p. 41, lns. 2-8; p. 46, lns. 12-16, Ex. 6).

Applicant's intended consumers are women between the ages of thirty and sixty-five (Creech Dep., p. 12, ln. 25; p. 13, lns. 1-14). An OXIUM user would be interested in anti-aging and cosmetic improvement procedures (Creech Dep., p. 13, lns. 4-14). Applicant intends to offer the OXIUM products in department stores, specialty skin care stores in malls, spas, medi-spas and dermatologist offices (Creech Dep., p. 12, lns. 6-24).

TherOx maintains a website at *oxium.com* but, again, no products are currently available under the OXIUM mark (Creech Dep., p. 53, lns. 18-25; p. 54, lns. 1-25; p. 55, lns. 1-11).

When Applicant selected its OXIUM mark, it was aware of Opposer's OXY products (Creech Dep., p. 15, lns. 11-15).

III. ARGUMENT

There is no question that Opposer has priority, in view of Opposer's pleaded registrations and in view of the testimony and evidence presented herein. Through its predecessor in interest, Opposer has sold its acne products in the United States under its OXY mark since the mid 1970's. Therefore, the only issue before the Board is whether or not Applicant's mark for OXIUM for oxygenated skin care preparations, namely, creams, masks, gels and lotions for the face, hands, feet and body, not including acne preparations is likely to cause confusion with Opposer's previously used and registered OXY Marks.

The T.T.A.B. uses a thirteen factor test to determine likelihood of confusion. The factors are:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
2. The similarity or dissimilarity and nature of the goods described in the application or registration or in connection with which a prior mark is used.
3. The similarity or dissimilarity of established, likely to continue trade channels.
4. The conditions under which and buyers to whom sales are made, i.e. "impulse" versus careful sophisticated purchasing.
5. The fame of the prior mark.
6. The number and nature of similar marks in use on similar goods.

7. The nature and extent of any actual confusion.
8. The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.
9. The variety of goods on which a mark is or is not used.
10. The market interface between the applicant and the owner of a prior mark.
11. The extent to which application has a right to exclude others from use of its mark on its goods.
12. The extent of potential confusion, and
13. Any other established fact probative of the effect of use.

In re Majestic Distilling Co., 315 F.3d 1311, 65 U.S.P.Q.2d 1201, 1203 (Fed. Cir. 2003); In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973).

Not all of these factors may be relevant or of equal weight in a particular case. See In re Dixie Restaurants, Inc., 105 F.3d 1405, 1406-1407, 41 U.S.P.Q.2d 1531, 1533 (Fed. Cir. 1997). Moreover, the fundamental inquiry in a likelihood of confusion determination is “the cumulative effect of the differences in the essential characteristics of the goods and the differences in the marks”. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 1103, 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976).

Opposer addresses the relevant factors below.

A. *The Marks Are Confusingly Similar*

When the Board assesses the similarity of two marks for purposes of likelihood of confusion, it considers the marks' appearance, sound and meaning. See DuPont at 1361, 567.

It is well settled that a subsequent user cannot usurp a prior user's mark in its entirety and succeed in dispelling confusion with additional wording. Saab-Scania Aktiebolag v. Sparkomatic Corp., 26 U.S.P.Q.2d 1709, 1710 (T.T.A.B. 1993) ("a subsequent user may not appropriate another's entire mark and avoid likelihood of confusion" R. J. Reynolds Tobacco Co. v. R. Seelig & Hille, 201 U.S.P.Q. 856 (T.T.A.B. 1978)). Here, Applicant has appropriated the OXY mark by changing Y to I and adding UM as a suffix. Such action illustrates the similarity of the marks and creates a likelihood of confusion.

1. Appearance

The parties' marks are similar in appearance. Both marks begin with OX followed by Y or I. Applicant has merely changed Opposer's OXY to OXI and added UM to create its mark. The addition of this wording does not distinguish Applicant's mark from Opposer's mark.

Moreover, the ordinary consumer retains only the most general, overall impression of an earlier trademark when faced with another trademark at a different place and time. 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:58 (2007); Dwight S. Williams Co., Inc. v. Lykens Hosiery Mills, Inc., 233 F.2d 398, 402 (4th Cir. 1956); W.G. Reardon Labs., Inc. v. B & B Exterminators, Inc., 3 F. Supp. 467, 476 (D. Md. 1933), modified, 71 F.2d 515 (4th Cir. 1934) (ordinary buyer retains only a "superficial impression."); see also, Daddy's Junky Music Stores v. Big Daddy's Family Music, 109 F.3d 275, 283 (6th Cir. 1997); Wynn Oil Co. v. American Way Serv. Corp., 943 F.2d 595, 601 (6th Cir. 1991) (Customers may

have a “general, vague or even hazy, impression or recollection” of the other party’s mark); Carlisle Chem. Works, Inc. v. Hardman & Holden, Ltd., 434 F.2d 1403, 168 U.S.P.Q. 110, 112 (C.C.P.A. 1970); Fleishmann Distilling Corp. v. Maier Brewing Co., 314 F.2d 149, 155 (9th Cir. 1963); Brown-Forman Distillery Co. v. Arthur M. Bloch Liquor Imps., Inc., 99 F.2d 708, 710 (7th Cir. 1938); Chesebrough Mfg. Co. v. Old Gold Chem. Co., 70 F.2d 383, 385 (6th Cir. 1934). It has long been recognized that consumers in general do not remember a mark’s details.

Consumers are also most likely to remember and recall the first portion of Applicant’s OXIUM mark - OXI. See Presto Prods. Inc. v. Nice-Pak Prods. Inc., 9 U.S.P.Q.2d 1895, 1897 (T.T.A.B. 1988) (purchasers often remember first part of a mark and the first portion of the mark is frequently the dominant element). Thus, consumers will remember the OXY and OXI portions of the parties’ marks and assume the products are related to one another. See Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 876, 23 U.S.P.Q.2d 1698, 1701 (Fed. Cir. 1992) (noting that both CENTURY and CENTURY LIFE OF AMERICA begin with CENTURY and “upon encountering each mark, consumers must first notice the identical lead word”).

OXY and OXIUM are similar in appearance.

2. Sound

The marks’ similarities in sound are undisputed. Both marks begin with OX and Y or I. Y and I are phonetic equivalents. In re Infinity Broadcasting Corp. of Dallas, 60 U.S.P.Q.2d 1214, 1217 (T.T.A.B. 2001). The dominant part of Applicant’s mark is OXI. The addition of UM simply cannot distinguish what are otherwise phonetically identical marks. Consumers are likely to assume OXIUM is a new addition to the OXY line.

3. Meaning

Neither OXY nor OXIUM has any known proscribed meaning.

Applicant indicated that OXIUM “seemed to convey oxygen in a positive light.” (Creech Dep., p. 14, lns. 16-25; p. 15, lns. 1-10). There was no consumer study or other evidence which suggested this.

However, the fact that both marks share the same two syllables - OXY and OXI - and that Applicant merely added UM as a suffix to OXI to create its mark suggests that any meaning is similar.

This factor, therefore, favors Opposer.

B. The Parties’ Goods Are Related.

Both parties offer skincare products under their respective marks. The parties’ goods have the same purpose: to improve the skin’s appearance. Applicant describes its goods as providing “fresher, younger-looking, even-toned, smooth, healthy skin.” (Creech Dep., Ex. 3, pp. 379-380). Opposer touts its OXY products as keeping one’s “skin healthy and smooth” (Cantrell Dep., Ex. 2).

The fact that Opposer’s registrations cover goods in International Class 5 and the goods in the OXIUM application fall in International Class 3 does not distinguish the products. “Classification is wholly irrelevant to the issue of registrability under section 1052(d), which makes no reference to classification.” Jean Patou Inc. v. Theon Inc., 29 U.S.P.Q.2d 1771, 1774 (Fed. Cir. 1993). The parties both offer skincare products.

In an attempt to distinguish its goods, Applicant amended its identification of goods to specifically exclude acne preparations - the goods covered by Opposer's registrations. However, it is common for mark owners to offer both acne preparations, which fall in International Class 5, and related skincare cosmetic goods, which fall in International Class 3.

During its testimony and rebuttal periods, Opposer submitted third-party registrations that cover skincare products in International Classes 3 and 5 to illustrate the related nature of the parties' goods. In other proceedings, the Board has recognized that third party registrations evidence the relatedness of goods/services. See Venture Out Properties LLC v. Wynn Resorts Holding LLC, 81 U.S.P.Q.2d 1887, 1892-1893 (T.T.A.B. 2007).

A number of the third-party registrations covering goods in Classes 3 and 5 comprise brands that Applicant considers to be competitors, specifically, registrations for PETER THOMAS ROTH; M.D. FORMULATIONS; PHYSICIAN'S CHOICE; E. EXCEL ELEMENTE; N.V. PERRICONE, M.D.; and M.D. FORTE (Creech Dep., p. 16, lns. 10-25; p. 17, ln. 1; p. 20, lns. 14-20, Ex. 2, p. 400). Accordingly, Applicant's competitors offer skincare products in both International Classes 3 and 5.

The parties' testimony evidence further illustrates the related nature of the OXIUM and OXY products. According to Applicant, Opposer's competitors have considered entering Applicant's intended market. "Mass market" manufacturers such as Neutrogena are interested in introducing products to what Applicant describes as the "prestige channel" for skincare - where Applicant intends to sell its goods (Creech Dep., p. 48, lns. 6-25, Ex. 4). Neutrogena is a direct competitor to Opposer's OXY products (Cantrell Dep., p. 48, lns. 8-10). The fact that one of

Opposer's direct competitors has plans to offer products directly competitive to Applicant's intended goods evidences that the OXY and OXIUM skincare products are related.

Applicant's potential customers also recognize the related nature of skincare products. Applicant conducted tests of its OXIUM product and had the OXIUM testers complete surveys to evaluate the product (Creech Dep., p. 31, lns. 19-25; p. 32, lns. 1-12). One OXIUM user indicated that she would like to see acne treatments in the OXIUM line (Creech Dep., Ex. 7, p. 342). Another tester used the OXIUM product to effectively treat "break outs" through "spot-treating" (Creech Dep., Ex. 7, p. 344). Applicant also organized focus groups to evaluate potential names for Applicant's product (Creech Dep., p. 37, lns. 4-13). More than one participant noted that the OXY prefix reminds them of anti-acne products (Creech Dep., Ex. 10, pp. 523, 528, 532).

The ingredients in the parties' goods further demonstrate that the OXIUM and OXY products are related. The patented ingredient in OXIUM - aqueous oxygen emulsion - could be used for over-the-counter anti-acne products (Creech Dep., Ex. 8, pp. 178, 183).

Applicant's competitors and Opposer use one of the same ingredients in their respective products - salicylic acid (Creech Dep., p. 37, lns. 20- 25; p. 38, lns. 1-6, Ex. 11; Cantrell Dep., p. 14, lns. 4-8). According to Applicant, this ingredient is considered an exclusive one and is the type of ingredient that distinguishes prestige skincare products from other skincare goods (Creech Dep., p. 37, lns. 20-25; p. 38, lns. 1-6).

Opposer's testimony further evidences that the parties' goods are related. Opposer intends to offer cosmetic goods that fall in International Class 3 under its OXY mark. Opposer filed an intent to use trademark application for the mark OXY for "Medicated or non-medicated soaps, facial scrubs and skin washes and pre-moistened or non-pre-moistened cosmetic wipes, shaving creams and gels, facial creams and lotions, skin moisturizers, sunscreen, anti-aging creams and lotions" on December 15, 2005. See Serial No. 78/774,055. These goods fall in International Class 3.

The marketplace also reflects that the parties' goods are related. Opposer's store customers, such as Wal-Mart, have buyers for skincare products (Cantrell Dep., Ex. 3). The skincare buyer at Wal-Mart is responsible for all types of skincare purchases for the store, including acne, facial moisturizers, masks, treatments for skin care and anti-aging products

(Cantrell Dep., p. 21, lns. 10-23; p. 22, lns. 1-23; p. 23, lns. 1-3). The Wal-Mart buyer purchases both acne products and anti-aging products for its store(s).

Moreover, the parties' goods are not used in isolated settings. A person could use both Opposer's OXY products and Applicant's OXIUM products. Applicant has not marketed its product in such a manner that the ultimate user is advised that the OXIUM product is not to be used with other skincare products (Creech Dep., p. 52, lns. 24-25; p. 53, lns. 1-6). A person could use both the OXIUM and OXY facial products.

The related nature of the parties' respective goods is undeniable.

This factor strongly favors Opposer.

C. The Parties' Channels of Trade Are Identical

There are no limitations on trade channels in the OXIUM application or in Opposer's OXY registrations. Identity in trade channels must therefore be concluded. See Packard Press, Inc. v. Hewlett - Packard Co., 227 F.3d 1352, 1360-1361, 56 U.S.P.Q.2d 1351, 1357 (Fed. Cir. 2000) ("When the registration does not contain limitations describing a particular channel of trade or class of customer, the goods or services are assumed to travel in all normal channels of trade"); Schieffelin & Co. v. Molson Cos. Ltd., 9 U.S.P.Q.2d 2069, 2073 (T.T.A.B. 1989) ("[M]oreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages"); see also Morton-Norwich Prods., Inc. v. N. Siperstein, Inc., 222 U.S.P.Q. 735, 736 (T.T.A.B. 1984) ("Since there is no limitation in applicant's identification of goods, we must presume that applicant's paints move in

all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers”).

Even though Applicant’s testimony shows that it does not currently plan to sell its products in the same retail outlets as Opposer’s goods, the Board compares the channels of trade as they are described in the application against those in the pleaded registrations. Octocom Sys., Inc. v. Houston Computers Servs. Inc., 918 F.2d 937, 941-942, 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sale of goods are directed”). The goods in the application are “oxygenated skin care preparations, namely, creams, masks, gels and lotions for the face, hands, feet, and body, not including acne preparations” and these are compared to Opposer’s acne medication in the form of washes, pads and spot treatments. Both parties would presumably sell their goods through any and all outlets or by any ordinary and customary means.

In short, since Applicant has not limited or restricted its channels of trade, this factor weighs in favor of Opposer.

D. Sophistication of Purchasers

Both parties have submitted evidence as to what price they sell their goods and indicated the nature or type of their respective purchasers. However, since neither Opposer nor Applicant has limited or restricted its identification in their respective registrations and application, the Board assumes the parties’ products are sold at all prices and to all potential purchasers.

[A]pplicant's evidence concerning the expensive nature of applicant's restaurant services and of registrant's wine ... are legally irrelevant and cannot be considered in our likelihood of confusion analysis. That analysis must be made on the basis of the goods and services as they are identified in applicant's application, i.e., 'restaurant services,' and in registrant's registration, i.e., 'wine,' regardless of what the evidence might show as to the nature of applicant's and registrant's actual goods and services. See Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A., 811 F.2d 1490, 1 U.S.P.Q.2d 1813 (Fed. Cir. 1987). Applicant's 'restaurant services' therefore must be presumed to encompass inexpensive or moderately-priced restaurant services, and registrant's 'wine' must be presumed to encompass inexpensive or moderately-priced wine. In view thereof, applicant's argument regarding the high cost of its actual restaurant services and of registrant's actual wine, and the resulting carefulness and sophistication of the purchasers, miss the mark. See In re Bercut Vandervoort & Co., 229 U.S.P.Q.2d 763 (T.T.A.B. 1986) (rejecting the applicant's arguments regarding the high cost and quality of its wine and the sophistication of its purchasers, where application identified as goods merely as 'wine')

See In re Opus One Inc., 60 U.S.P.Q.2d 1812, 1818 (T.T.A.B. 2001). The Board has specifically noted that the fact that a particular product may be "expensive" does not change the analysis:

Accordingly, in the present case, evidence and/or argument relating to the fact that the particular wines sold under the marks are expensive, high quality wines sold in high-quality wine and spirits stores to discriminating, sophisticated purchasers who would likely be familiar with the vineyard naming customs in France must be disregarded since there is no restriction in the application or registration limiting the goods to particular channels of trade or classes of customers.

In re Bercut-Vandervoort, 229 U.S.P.Q. 763, 765 (T.T.A.B. 1986).

Both parties' goods in the application and registrations are not limited to a particular group of purchasers. In addition, there are no price point restrictions to indicate the price of Applicant's or Opposer's goods. The evidence of record illustrates the different price points

“must be disregarded” given the identifications in the contested application and pleaded registrations.

Nonetheless, the parties’ testimony indicates that the parties’ purchasers are the same. Opposer testified that women between the ages of thirty-five and fifty-five purchase OXY products for their children (Cantrell Dep., p. 18, lns. 5-11, -confidential portion- Ex. 13). Opposer actively promotes its OXY products to this demographic (Cantrell Dep., p. 30, lns. 9-22, Ex. 8).

Applicant’s testimony indicates that Applicant intends to offer its OXIUM product to women in the thirty to sixty-five age range (Creech Dep., p. 12, ln. 25; p. 13, lns. 1-14).

The parties clearly will market their respective products to the same customers.

Since Applicant has not limited its identification of goods to indicate the exact nature of its intended purchasers, the identity of the parties’ purchasers and therefore the sophistication of the purchasers must be assumed. The sophistication of the purchasers prong of the Dupont analysis favors Opposer.

E. Fame of the OXY Mark

When a mark has achieved fame in the marketplace, that mark “deserves and receives more legal protection than an obscure or weak mark.” Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 353, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992). The Federal Circuit has specifically held that “fame of a mark is a **dominant** factor in a likelihood of confusion

analysis for a famous mark, independent of the consideration of the relatedness of the goods.”
Recot Inc. v. Becton, 214 F.3d 1322, 1327, 54 U.S.P.Q.2d 1884, 1898 (Fed. Cir. 2000)
(emphasis added).

The OXY Marks have achieved such fame and the record in this case establishes this fame.

Since the mid 1970s, the OXY mark has been used to identify Opposer’s line of acne products. During this thirty year period, Opposer’s OXY marks have become well-known and famous. In fact, generations of people have been exposed to OXY advertising, promotion and in-store placement.

For over thirty years, OXY products have been advertised on television (Brown Dep., Exs. 4 and 5, Cantrell Dep., Ex. 4). Generations have seen these advertisements and grown up with the OXY brand of acne medication.

Other evidence of fame includes print advertisements that have run in various national publications, as seen from the OXY media plans and actual use (Brown Dep., -confidential

portion- Ex. 12; Cantrell Dep., Ex. 4). These national publications include Teen People, Sports Illustrated for Teens, MAD Magazine and DC Comics as well as many others (Brown Dep., p. 23, lns. 14-18; -confidential portion- Ex. 12; Cantrell Dep., Ex. 4). SmithKline also interacted directly with writers of national publications by sending consumer press kits for the OXY products (Brown Dep., p. 44, lns. 20-25; p. 45, lns. 1-13, Ex. 11).

The OXY brand has been promoted on the Internet for many years and these promotional campaigns further illustrate the breadth of recognition of the OXY brand. During SmithKline's 2004 Internet contest, the OXY website at *oxyoxygen.com* received 989,000 visitors (Brown Dep., Ex. 7). Moreover, just under 38 million messages were sent with the OXY instant messaging system (Brown Dep., Ex. 7). There were over 6.9 million people who used the OXY instant messaging program (Brown Dep., Ex. 7). Over 840 million people saw the instant messaging imagery (Brown. Dep., Ex. 7). Millions of people had exposure to the OXY brand through this one promotion.

A second promotion encouraged loyalty among OXY purchasers and offered a chance to win tickets to the MTV music video awards show (Brown Dep., p. 42, lns. 16-23, Ex. 8). Purchasers who visited the OXY website could obtain free items such as movie downloads and the like (Brown Dep., p. 41, lns. 23-25; p. 42, ln. 1, Ex. 9). This promotion gave the OXY brand extensive visibility.

Recent online promotions include the "Support Your Jock" contest (Cantrell Dep., p. 38, lns. 12-17, Ex. 12). The online promotion is in conjunction with the MTV television show 2-a-Day which follows a high school football team (Cantrell Dep., p. 38, lns. 18-22). Opposer is one of the primary sponsors of the television show (Cantrell Dep., p. 38, ln. 23, p. 39, lns. 1-7). The

online contest provides students with the chance to win \$25,000 for their school athletic programs and daily prizes for themselves (Cantrell Dep., p. 38, ln. 23, p. 39, lns. 1-7).

Opposer has expanded marketing efforts for the OXY brand since acquiring the marks and product line. For example, Opposer's sponsorship of the Dew Tour is a new promotion for the OXY brand. The exposure is impressive: the Dew Tour draws 15,000 to 20,000 people each day for four days in five cities (Cantrell Dep., p. 27, ln. 23; p. 28, lns. 1-3). Thousands of people encounter the OXY mark at the Tour (Cantrell Dep., Exs. 5 and 6). Opposer heavily promotes this sponsorship on television - over 270 OXY commercials ran on MTV between July and September 2005 (Cantrell Dep., p. 31, lns. 21-23, Ex. 4). Television viewers' exposure to the OXY brand also occurs on ESPN through Opposer's sponsorship of two athletes who competed in the 2005 Summer X Games (Cantrell Dep., p. 33, lns. 17-23; p. 34 lns. 1-2, Ex. 10). Like Mirra, these athletes had OXY on their helmets (Cantrell Dep., Ex. 10). Opposer also contracts with MTV for product placement on the television show Real World. (Cantrell Dep., p. 34, lns. 13-21). This further evidences the public's exposure to the OXY brand.

Other new promotions include Opposer's sampling at sports camps for high school students. These camps collectively enroll over 600,000 children (Cantrell Dep., p. 39, lns. 15-23; p. 40, lns. 1-6). Opposer distributes packets to each camp attendee; the packet includes a product sample, a coupon, a calendar and information about skincare and hygiene (Cantrell Dep., p. 39, lns. 15-23; p. 40, lns. 1-6).

The quality of the OXY branded products further enhances the fame of the OXY mark. A survey conducted by the National Pharmacists Association in 2005 found Opposer's OXY

products to be the number one recommended acne product (Cantrell Dep., p. 15, lns. 14-23; p. 16, lns. 1-4).

People encounter the OXY products at almost any retail outlet (Cantrell Dep., p. 17, lns. 18-22). Public exposure to the brand is vast.

Recent advertising and sales figures for the OXY brand both when it was held by SmithKline Beecham and now as held by Mentholatum have also been made available. These figures evidence extensive sales and promotion of the OXY product.

As further evidence of the fame of Opposer's OXY Marks, Opposer notes that Applicant admitted to having knowledge of the OXY brand prior to selecting its mark (Creech Dep., p. 15, lns. 11-15, Ex. 2, p. 0399). See Recot, 54 U.S.P.Q.2d at 1897-1898 ("When a famous mark is at issue, a competitor must pause to consider carefully whether the fame of the mark, accorded its full weight, casts a 'long shadow which competitors must avoid.'") (citations omitted). Given the wide variety of stores OXY products are sold at, this admission is not surprising. Consumers are exposed to the OXY brand thru radio, television, print and Internet advertising as well as in almost any type of retail outlet that sells personal care items, and have been exposed for thirty years. The OXY brand reaches a wide audience. In fact, Applicant's testimony reveals that "'OXY-' screams anti-acne medication" (Creech Dep., Ex. 2, p. 0399). Participants in Applicant's focus groups and test market groups associated OXY with anti-acne products (Creech Dep., Ex. 7).

There is no question that the OXY brand is famous and well-known for acne medication and this factor, therefore, strongly favors Opposer.

F. *Lack of Evidence of Third Party Use of Oxy*

There is no evidence of record showing third party use of OXY for skincare products. OXY is not diluted in the field of skincare.

The lack of third party uses broadens the scope of protection to which the OXY mark is entitled and suggests the propensity of consumers to be confused when confronted with other OXY marks, such as OXIUM. Jockey Inter'l Inc. v. Butler, 3 U.S.P.Q.2d 1607, 1612 (T.T.A.B. 1987); Fruit of the Loom Inc. v. Fruit of the Earth Inc., 3 U.S.P.Q.2d 1531, 1536-1537 (T.T.A.B. 1987) (“applicant found no third party use or registration of any mark consisting of ‘FRUIT OF THE’ followed by some other term in either the clothing or cosmetic field. The dearth of any relevant third party marks demonstrates the uniqueness of opposer's mark, a factor which, in addition to the mark's unquestioned fame, increases the propensity of purchasers to be confused when confronted with similar marks of others”) (citations omitted). OXY is alone in its field as Applicant has admitted.

This DuPont factor favors Opposer.

G. *Actual Confusion*

There is no evidence of actual confusion of record.

The statutory test is likelihood of confusion, 15 U.S.C. §1052(d), not actual confusion.

As the Federal Court of Appeals has stated:

Before this court, the test is likelihood of confusion, not actual confusion. Wella Corp. v. California Concept Corp., 558 F.2d 1019, 1023, 194 U.S.P.Q. 419, 423 (CCPA 1977); and Application of Bissett-Berman Corp., 476 F.2d 640, 642, 177 U.S.P.Q. 528, 529-30 (CCPA 1973). It is unnecessary to show actual confusion

in establishing likelihood of confusion. Giant Food, Inc., 710 F.2d at 1571, 218 U.S.P.Q. at 396.

Weiss Assos. Inc. v. HRL Assos. Inc., 14 U.S.P.Q.2d 1840, 1842-1843 (Fed Cir. 1990).

Moreover, the absence of actual confusion cannot outweigh the other factors showing that confusion is likely.

Applicant's product was only available for a short period of time and in only a very few isolated locations (Creech Dep., p. 27, Ins. 20-25; p. 28, Ins. 1-14). Sales were miniscule (Creech Dep., Ex. 14). The OXIUM product is not currently available (Creech Dep., p. 21, Ins. 22-25; p. 22, Ins. 1-11). There has simply not been an opportunity for confusion to occur. See Interstate Brands Corp. v. McKee Foods Corp., 53 U.S.P.Q.2d 1910, 1915 (T.T.A.B. 2000) (finding two year time period of parties selling their respective goods to be "relatively brief").

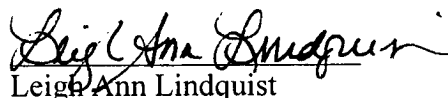
This factor is neutral.

IV. CONCLUSION

The marks are clearly similar in appearance, sound and connotation. The parties both offer skincare products under their respective marks. For over thirty years, the OXY mark has been extensively advertised and promoted, and has been widely available for purchase. OXY is a famous and well-known mark for skincare products.

As shown above, the relevant DuPont factors favor Opposer. Applicant's OXIUM mark is simply too close to Opposer's well-known and famous OXY mark. In short, the DuPont factors indicate that consumers are likely to be confused by these two marks. Opposer has made the requisite showing of likelihood of confusion and respectfully requests that its Opposition be sustained and Applicant's OXIUM mark be denied registration.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Leigh Ann Lindquist".

Leigh Ann Lindquist

Gary D. Krugman

SUGHRUE MION, PLLC

2100 Pennsylvania Avenue, N.W.

Washington, D.C. 20037

Tele.: 202.663.7409

Facs.: 202.293.7860

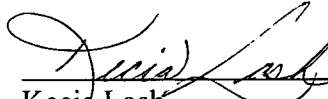
Attorneys for Opposer - The Mentholatum Company

Date: April 9, 2007

CERTIFICATE OF SERVICE

I, Kecia Lash, an employee of Sughrue Mion, PLLC hereby certify that on this 9th day of April, 2007, a true and correct copy of the foregoing **REPLY BRIEF OF OPPOSER (including confidential portions)** has been properly served, via First Class U.S. Mail, postage prepaid to:

Tawnya R. Wojciechowski, Esq.
TRW Law Group
Newport Gateway, Tower Two
19990 MacArthur Boulevard, Suite 1150
Irvine, CA 92612



Kecia Lash
Sughrue Mion, PLLC